UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,495	12/05/2003	Alan C. Berkema	200310639-1	9731

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER
HOANG, DANIEL L

ART UNIT	PAPER NUMBER
2136	

NOTIFICATION DATE	DELIVERY MODE
12/31/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5,8,10-18,21,23-32,35,38 and 40* is/are pending in the application.

   4a) Of the above claim(s) *3, 4, 6, 7, 9, 19, 20, 22, 33, 34, 36, 37, and 39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5,8,10-18,21,23-32,35,38 and 40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some *   c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

RESPONSE TO ARGUMENTS

As it is clear from the applicant's remarks, applicant is relying on the **printing the PIN** limitation on

independent claims 5, 13, 26, 35, and 43 all respective dependent claims to distinguish the claims from

the rejections of the record. The original claims recite **publishing the PIN**. The specification is clear that

the invention as originally claimed and described is indifferent to the nature and specifics of establishing a

paring between devices. The decision in *perdue pharma L.P.V. Faulding Inc.* 52 USPQ2d 1481, 1486

(CAFC 2000) reads in pertinent part:

> The case of *In re Ruschig,* 379 F.2d 990, 154USPQ 118 (CCPA 1967), is instructive
>
> here. In that case our predecessor court affirmed the holding of the Patent Office Board of
>
> Appeals that one of the claims, adopted for purposes of interference, was not supported by the
>
> disclosure. The claim at issue in that case was directed to a single compound. The applicant
>
> argued that, although the compound itself was not disclosed, one skilled in the art would find
>
> support for the claimed compound in the general disclosure of the genus of compound to which
>
> the claimed compound belonged. The *Ruschig* court rejected that argument, stating that it is an
>
> old custom in the woods to mark trails by making blaze mark on the trees. It is of no help in
>
> finding a trail or in finding one's way through the woods where the trails have disappeared or
>
> have not yet been made, which is more like the case here to be confronted simply by a large
>
> number of unmarked trees, we are looking for blaze marks which single out particular trees. We
>
> see none. Id. At 994-95, 154 USPQ at 122. ...As *ruschig* makes clear, one can not disclose a
>
> forest in the original application, and then later pick a tree out of the forest and say "here is my
>
> invention." In order to satisfy the written description requirement, the blaze marks directing the
>
> skilled artisan to that tree must be in the originally filed disclosure. See id. At 994-95, 154 USPQ
>
> at 122; *Fujikawa,* 93 F.3d at 1570-71, 39 USPQ2d at 1905; *Martin v. Mayer,* 823 F.2d 500, 505, 3
>
> USPQ2d 1333, 1337(Fed. Cir. 1987) ("It is not a question of whether one skilled in the art might

be able to construct the patentee's device from the teachings of the disclosure. ... Rather, it is a

question whether the application necessarily discloses that particular device.")(quoting *Jepson v.*

Coleman, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963)). In this case, the

specification teaches:

The following description of applicant's method to establish a pairing between devices **is not**

meant, however, to limit applicant's invention to either printing devices, mobile phones, or

headsets, <u>as the invention herein can be applied to any peripheral device capable of implementing</u>

<u>wireless technology in general</u> (See applicant's background, paragraph 0001-0002). Thus, applicant's

invention at the time the application was filed, did not depend on a particular device. The specification is

not singling out printing devices or leading one of ordinary skill to the selection of printing devices over

any others as is required for an adequate written description. The written description does not provide

evidence of an actual reduction to practice using printing devices. Thus the invention as now claimed,

differs from the invention as originally described in the original disclosure. Therefore, while the application

is enabling for a printing device as claimed, the disclosure does not describe in full, clear, concise, and

exact terms the printing device that is now being claimed.

CLAIMS PRESENTED

Claims 1, 2, 5, 8, 10-18, 21, 23-32, 35, 38, 40-49 are pending.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 5, 31, 35, 48 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Willey, US PGP No. 20030065918.

As per claim 1, 31, 48, Willey teaches:

A method for publishing a PIN for use in establishing a pairing with a printing device, comprising: the printing device generating the PIN in response to a local PIN request; and

> *[see paragraph 0041]*

the printing device printing the PIN.

> *[see paragraph 0042]*

Examiner acknowledges with applicant's argument that Willey does not specifically teach pairing with a

printing device. While this is true, Willey's invention is geared towards the pairing of bluetooth devices.

As evident in applicant's background, bluetooth pairing can be between a mobile phone and a headset, a

mouse and personal computer, or a PDA and a printer. Although Willey does not specifically teach

pairing with a printer, examiner deems that pairing with a printer or any other device capably equipped

with wireless technology would be obvious to one of ordinary skill in the art. Applying this technology to a

printer would allow for secure pairing between wireless printers and other devices.

As per claim 5, 35, Willey teaches:

A method for initializing a device pairing, comprising: generating a PIN in response to a local PIN request;

> *[0041]*

printing the PIN;

> *[0042]*

receiving a connection request with PIN data; and

> *[0048]*

generating a link key using the PIN data, the link key used for device pairing.

> *[0048]*

Please see examiner's comments above in claim 1 regarding printing the PIN.

3.   Claims 2, 8, 10-12, 38, 40-42, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willey as applied to claim 1 or 5 above, and further in view of Slick et al., US PGP No. 20030105963.

As per claim 2, 8, 38, 48:

The method of claim 1, identifying a local request to print a test page as the local PIN request and wherein printing the PIN comprises printing a test page that includes the PIN.

The Willey reference has been discussed above. Willey does not explicitly disclose identifying a local request to print a test page as the local PIN request wherein printing the PIN comprises printing a test page that includes the PIN.

The Slick reference teaches the above limitation not disclosed by Willey (see Slick, paragraph 0019). It would have been obvious to one of ordinary skill in the art to combine the above teachings of Willey with that which is taught by Slick so that a user "can view the predetermined [PIN] from the test page and then enter the [PIN] into the computing device".

As per claim 10, 40, Willey teaches:

The method of claim 5, further comprising determining the validity of the PIN data prior to generating the link key.

[0048]

As per claim 11, 41, Willey teaches:

The method of claim 10, wherein determining includes determining if the PIN data corresponds to the PIN, determining if the generated PIN has expired, and rejecting the connection request if the PIN data does not correspond to the PIN or if the PIN has expired.

[0043-0047]

As per claim 12, 42:

Claim 12 reads as follows: ·

The method of claim 5 further comprising rejecting the connection request if the connection request is for a function not associated with the PIN data.

The Willey reference does not explicitly teach to reject a connection request if the request is for a function not associated with the PIN data. The PIN data identifies the device seeking connection. It would be obvious the reject the connection request from a device such as a headset seeking to communicate with a printer because a headset would have no need to connect with a printer.

5.   Claims 13, 23, 26, 30, 31, 43, are rejected 35 U.S.C. 103(a) as being unpatentable over Phillips, US Patent No. 6748195.

As per claim 13, 23, 26, 30, 31, 43, Phillips teaches:

A method for establishing a pairing between a claimant device and a verifying device, comprising:

generating a PIN in response to a local PIN request made to the verifying device;

instructing the verifying device to print the PIN;

receiving from the claimant device a connection request, the connection request including PIN data;

    [col. 5, lines 48-59]

determining whether a link key exists for the verifying device;

    [col. 5, lines 59-65]

if a link key exists:

        rejecting the connection request if the verifying device is not multi-claimant enabled;

            [col. 7, lines 3-17]

        rejecting the connection request if the verifying device is multi-claimant enabled with restricted

        access and the claimant device is not approved;

            [col. 7, lines 3-17]

otherwise, upon a determination that the PIN data is valid, generating a link key from the PIN data to establish a pairing between the claimant device and the verifying device.

> *[col. 6, lines 1-10]*

Examiner acknowledges with applicant's argument that Phillips does not specifically teach pairing with a printing device. While this is true, Phillip's invention is geared towards the pairing of bluetooth devices. As evident in applicant's background, bluetooth pairing can be between a mobile phone and a headset, a mouse and personal computer, or a PDA and a printer. Although Phillip does not specifically teach pairing with a printer, examiner deems that pairing with a printer or any other device capably equipped with wireless technology would be obvious to one of ordinary skill in the art. Applying this technology to a printer would allow for secure pairing between wireless printers and other devices.

6.   Claims 15-18, 21, 23, 25, 28-30, 32, 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips as applied to claim 13 above, and further in view of Willey, US PGP No. 20030065918.

As per claim 15, 28, 45:

The method of claim 14, wherein the PIN and the PIN data are of the same format and wherein determining the validity of the PIN data includes determining if the PIN data matches the generated PIN.

> *Phillips does not explicitly disclose verification of PIN data. Willey teaches this limitation, (see Willey, paragraph 0050). It would have been obvious to combine this teaching of Willey with the Phillips reference in order to validate the PIN. Validating the PINs ensures both devices are verified to communicate with each other.*

As per claim 16, 29, 46:

The method of claim 14, wherein determining the validity of the PIN data comprises: acquiring a unique

identifier for the claimant device; constructing verifying PIN data using the unique identifier and the

generated PIN; determining if the PIN data matches the verifying PIN data.

Phillips does not explicitly disclose verification of PIN data. Willey teaches this limitation, (see

Willey, paragraph 0050). It would have been obvious to combine this teaching of Willey with the Phillips

reference in order to validate the PIN. Validating the PINs ensures both devices are verified to

communicate with each other.

As per claim 17, 18, 30, 47:

A method for establishing a pairing between a claimant device and a printing device, comprising:
generating a PIN in response to a local request to print a test page made to the printing device;

    [see rejection of claims 1 and 2]

instructing the printing device to print a test page that includes the PIN;

    [see rejection of claim 2]

receiving from the claimant device a connection request, the connection request including PIN data;

    [Phillips, col. 5, lines 48-59]

determining whether a valid link key exists exist for the printing device;

    [Phillips, col. 5, lines 59-65]

if a valid link key exists:

    rejecting the connection request if the printing device is not multi-claimant enabled;

        [Phillips, col. 7, lines 3-17]

    rejecting the connection request if the printing device is multi-claimant enabled with restricted

    access and the claimant device is not approved;

        [Phillips, col. 7, lines 3-17]

otherwise, upon a determination that the PIN data is valid, generating a link key from the PIN data to

establish a pairing between the claimant device and the printing device.

    [Phillips, col. 6, lines 1-10]

As per claim 21, 32:

The method of claim 18, identifying a local request to print a test page as the local PIN request and wherein printing the PIN comprises printing a test page that includes the PIN.

The Willey reference has been discussed above. Willey does not explicitly disclose identifying a local request to print a test page as the local PIN request wherein printing the PIN comprises printing a test page that includes the PIN.

The Slick reference teaches the above limitation not disclosed by Willey (see Slick, paragraph 0019). It would have been obvious to one of ordinary skill in the art to combine the above teachings of Willey with that which is taught by Slick so that a user "can view the predetermined [PIN] from the test page and then enter the [PIN] into the computing device".

As per claim 23, Willey teaches:

The medium of claim 18, having further instructions for determining the validity of the PIN data prior to generating the link key.

[0048] It would have been obvious to combine this teaching of Willey with the Phillips reference in order to validate the PIN. Validating the PINs ensures both devices are verified to communicate with each other.

As per claim 24, Willey teaches:

The medium of claim 23, wherein the instructions for determining include instructions for determining if the PIN data corresponds to the PIN, determining if the generated PIN has expired, and rejecting the connection request if the PIN data does not correspond to the PIN or if the PIN has expired.

[0043-0047] It would have been obvious to combine this teaching of Willey with the Phillips reference in order to validate the PIN. Validating the PINs ensures both devices are verified to communicate with each other.

As per claim 25:

The medium of claim 18, having further instructions for rejecting the connection request if the connection

request is for a function not associated with the PIN data.

The Willey reference does not explicitly teach to reject a connection request if the request is for a

function not associated with the PIN data. The PIN data identifies the device seeking connection. It

would be obvious the reject the connection request from a device such as a headset seeking to

communicate with a printer because a headset would have no need to connect with a printer.

POINTS OF CONTACT

*.   Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

> Customer Service Window
> Randolph Building
> 401 Dulaney Street
> Alexandria, VA 22314

*.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Daniel L. Hoang whose telephone number is 571-270-1019. The examiner can normally

be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where

this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained from

either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Hoang
12/18/07

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

12/20/07